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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949

No. 289

REMINGTON RAND INC.,

Petitioner,

v.

ROYAL TYPEWRITER COMPANY, INC.,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This petition seeks a review by this Court of an order of the Second Circuit Court of Appeals denying a petition to reopen a patent case to raise the defense of invalidity for lack of invention. The patent 1,961,905 to Woodfine, issued on July 4, 1933, will expire on July 4, 1950. On May 21, 1948 (1st Rec., 256) the Court of Appeals affirmed a judgment of the District Court of Connecticut holding the patent infringed over a defense of non-infringement based on alleged limitation of the claims by the prior art.

The petition to reopen was not filed until a year and one month later, on June 22, 1949 (2d Rec., 1)*.

* This is the third application by petitioner seeking review in this Court. A petition for certiorari seeking review of the Court of Appeals decision affirming the District Court judgment was denied on October 11, 1948, and a subsequent petition for rehearing was denied on November 11, 1948.

The Court of Appeals, in denying the petition to reopen, exercised a sound discretion and therefore its decision presents nothing reviewable

Since the judgment had been affirmed, the petition to reopen was properly addressed to the appellate court in the first instance. An application for leave to reopen is addressed to the sound discretion of the appellate court and will be denied unless the petition, and the papers filed in support of it, meet the requirements as to the materiality of the new matter and as to diligence in its presentation.

In *Hazel-Atlas etc. Co.* v. *Hartford-Empire Co.* (1944), 322 U. S. 238, 248, this Court said:

> "The hearing conducted by the appellate court on the petition * * * is not just a ceremonial gesture. The petition must contain the necessary averments, supported by affidavits or other acceptable evidence; and the appellate court may in the exercise of a proper discretion reject the petition * * *. *National Brake Co.* v. *Christensen,* 254 U. S. 425, 430-433."

In *National etc. Co.* v. *Christensen* (1921), 254 U. S. 425, 430, the Court said:

> "Such applications are addressed to the sound discretion of the appellate tribunal, and should be decided upon considerations addressed to the materiality of the new matter and diligence in its presentation."

The averments necessary on such a petition are

(1) That the petition has been filed promptly after the discovery of the new evidence (*Simmons Co.* v. *Grier etc. Co.,* 258 U. S. 82, 91);

(2) That the failure to discover the evidence in time for the trial was not due to a lack of diligence (*Toledo Scale Co.* v. *Computing Scale Co.*, 261 U. S. 399, 421); and

(3) That the character of the evidence is such that if received it will affect the decree already rendered (*Rubber Co.* v. *Goodyear*, 9 Wall. 805, 806).

The petition to reopen contained none of these essential averments and the affidavit in support of the petition failed to make any showing with respect to these indispensable prerequisites for a reopening. Indeed it appears from an examination of the petition and supporting affidavit that all substantial items of the evidence sought to be introduced by the reopening were not only available at the time of the original trial but were introduced in evidence and considered by the courts below. Under these circumstances it can hardly be contended that the Court of Appeals failed to exercise a sound discretion in considering and denying the petition for reopening. Indeed the opinion by Judge Learned Hand (1st Rec., 256-7) shows that the court gave careful consideration to the propriety of accepting defendant's (petitioner's) concession of validity under the circumstances of this case and in the light of this Court's more recent pronouncements. That being so, the order denying the petition to reopen would not under the decisions of this Court be reviewable.

In *Wayne United Gas Co.* v. *Owens-Illinois Glass Co.*, 300 U. S. 131, 137, this Court said:

> "The granting of a rehearing is within the court's sound discretion, and a refusal to entertain a motion therefor, or the refusal of the motion, if entertained, is not the subject of appeal."*

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* See *Steines* v. *Franklin County*, 14 Wall. 15, 22; *Buffington* v. *Harvey*, 95 U. S. 99, 100; *Railway Co.* v. *Heck*, 102 U. S. 120; *Kennon* v. *Gilmer*, 131 U. S. 22, 24; *Roemer* v. *Bernheim*, 132 U. S. 103, 106; *Boesch* v. *Gräff*, 133 U. S. 697, 699.

Petitioner's contentions, reached by extension of certain remarks culled from opinions of this Court, are not in fact supported anywhere as a matter of decision; their acceptance would overturn the law established by repeated decisions of this Court and would establish an impracticable precedent of most baneful effect

The burden of the present petition is that in patent cases where the defendant does not challenge the validity of the patent, the district court has the duty to and must in all cases initiate an investigation into that question either by appointing its own master or expert to conduct the investigation or by calling in the law officers of the United States, and that where the court fails to do so, the defendant, however negligent, may nevertheless raise the question of validity at any time because of the public interest.

It may be conceded that the public interest in the patent system is dominant and that as a result where defendant challenges the validity of the claims as well as their infringement, it is the better practice to pass on both issues; that a court may act *sua sponte* to strike down a patent that is invalid either on its face or on uncontrovertible evidence in the record, and that where a sound defense going to validity exists, public policy is promoted by the making of the defense and contravened by defendant's refusal to make it.

It is a long step, however, from these propositions to petitioner's contention here. That contention in effect is that even where the patent presents no evidence of invalidity on its face and defendant, having presumably determined in its best judgment that no good defense of invalidity exists, concedes validity, the court cannot enter a decree of infringement without first initiating an investigation to determine for itself whether there is any defense.

The acceptance of this contention would in effect overrule a century of precedents of this Court. In *Seymour* v. *Osborne,* 11 Wall. 516, 538, this Court said:

> "* * * the law is well settled that the letters patent in question, where they are introduced in evidence in support of the claim, if they are in due form, afford a *prima facie* presumption that the first-named allegation [that the patentees are the original and first inventors] is true, and the rule is equally well settled that that presumption, in the absence of satisfactory proof to the contrary, is sufficient to entitle the party instituting the suit to recover for the alleged violation of the exclusive rights secured to him in the letters patent."

Similar statements of the law appear in the following Supreme Court cases: *Agawam Co.* v. *Jordan,* 7 Wall. 583, 596; *Blanchard* v. *Putnam,* 8 Wall. 420, 424-5; *Mitchell* v. *Tilghman,* 19 Wall. 287, 390-1; *Cammeyer* v. *Newton,* 94 U. S. 225, 230-1; *Bates* v. *Coe,* 98 U. S. 31, 40; *Imhaeuser* v. *Buerk,* 101 U. S. 647, 662; *Parks* v. *Booth,* 102 U. S. 96, 99; *Cantrell* v. *Wallick,* 117 U. S. 689, 695; *Mumm* v. *Decker & Sons,* 301 U. S. 168, 171.

It is also apparent on reflection that the rule for which petitioner contends is an impracticable one. It would indeed make litigation in patent cases immortal while men remain mortal, to invert Justice Story's famous remark*. This fact is somewhat masked by petitioner's reference to the defense of invalidity in the singular. Actually, of course, there are many defenses which may be raised to a patent. Aside from novelty and invention, there are the defenses of new matter, improper claiming, failure of complete or adequate disclosure, lack of utility, public use, or publication more than one year prior to the filing of

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* See *Toledo Co.* v. *Computing Co.,* 261 U. S. 399, 425.

the application, abandonment, delay in claiming, to mention only a few. The logic behind petitioner's contention would require a court to reopen the case again and again at any stage whenever defendant raises a defense of invalidity not previously made in the case, regardless not only of defendant's negligence but of all considerations of public policy that underlie the doctrines of laches, estoppel, and *res adjudicata.*

If this Court wished to deal a death blow to the patent system, we can think of no expedient that would be more effective than the adoption of petitioner's contention. Expensive as patent litigation is at present, the rule contended for would place in the hands of defendant a means of increasing the costs to a prohibitive degree*.

Indeed, even the expedient of having the court initiate its own investigation where no issue as to validity is raised by the parties would not guard against subsequent reopenings, since, according to the rule advanced, it would be the court's duty to consider any defense subsequently suggested by defendant which had not been considered by the court on the investigation. Such a rule would lead to chaos.

The questions raised by petition are not presented by the case

The questions are predicated on the assumption that the District Court had no adequate means to decide the issue of validity (presumably here the question of invention) (Petition, 1-2).

* The present case itself presents a premonitory sample of what would follow. In a straightforward patent case, tried simply and inexpensively (the record is unusual in its brevity), the affirmance of the judgment is followed by three applications to this Court and one to the Circuit Court of Appeals, all requiring the attention of numerous counsel and adding greatly to the expense of the litigation.

While defendant did not press any invalidity defense in the District Court, it did advance on the issue of infringement all of the pertinent prior patents to limit the scope of the claims. These patents were discussed by defendant's expert and some of them by plaintiff's expert (1st Rec., 46-57; 60-64). The defense of non-infringement based on limitation by the prior art can hardly be distinguished in anything more than legalistic fantasy from the defense of invalidity, as the case demonstrated. The prior art patents and their relation to or bearing on the patent in suit were discussed both in argument and in the briefs as fully as if the defense of invalidity were present. The District Court considered and discussed the prior art and held the patent valid in its light (1st Rec., Opinion, 234, f. 701, and 235; 241, f. 722, to 242, f. 725; Findings of Fact, 244-245, F. 10-13; 246, F. 17-18).

The petition repeatedly refers to Judge Hand's generalized statement that where validity is not questioned the defendant "then puts in no evidence * * * and the court has therefore no adequate means to decide the issue". But the fact is that in its decision in this case the Court of Appeals did take into consideration the prior art. In the very next paragraph Judge Hand says:

> "Coming then to the question of infringement, we are first to interpret the claims in the light of disclosure; and both the claims and the disclosure in the setting of the prior art" (1st Rec., 257).

And in evaluating the nature of the patent's contribution in the light of the prior art, he said that the patented device

> "did add a convenient novelty to the typewriter, a machine on which a vast amount of ingenuity had been expended, and which had for long offered a place for just such an improvement. Moreover, although the record amply proves that 'margin stops' them-

selves had received much attention and had been the subject of a number of patents, nobody had ever before worked out their automatic return; and that was a change which has proved of substantial service" (1st Rec., 258; 168 F. (2) 691, 693).

The prior art now sought to be introduced by reopening is set forth in the moving papers (2d Rec., pp. 3-42). It adds nothing to the showing already considered by the courts below. All of the patents of Group B (2d Rec., 3) except the Dillon patent, were introduced into evidence at the trial of the case. The Dillon patent is merely another example of a type of device shown in a number of the patents already in evidence and discussed by the trial court in its Findings Nos. 11 and 12 (1st Rec., 245; see also Opinion, p. 235, f. 704). The patents in Group A with the exception of the Benzing patent, which is of later date than the patent in suit, are stated to show in diverse arts the use of a spring to cause quick automatic movement of an element as a substitute for manual movement. But the ordinary typewriter carriage—in this very art—is an exemplification of this expedient, as the petition recognizes (p. 11). So these spring patents add nothing to the case that was not already before the court. They are merely cumulative, and more remote than the evidence at the trial.

We shall not burden the Court with a discussion of the merits of the patent case. It is sufficient to point out that the argument in the petition is based on an over-simplification of the issues. Compare the definition of the invention on page 10 of the petition under the sub-heading "Nature of the Alleged Invention" with the definition of the invention by the District Court in Finding 13 (1st Rec., 245; and see Opinion, 234-5; ff. 702-3) and compare also with the statement made by the Court of Appeals in the portion of its opinion quoted above (*ante*, pp. 7-8).

Conclusion

We respectfully submit the petition should be denied because

(1) The Court of Appeals, in denying the petition to reopen, exercised a sound discretion and therefore its decision presents nothing reviewable.

(2) Petitioner's contentions, reached by extension of certain remarks culled from opinions of this Court, are not in fact supported anywhere as a matter of decision; their acceptance would overturn the law established by repeated decisions of this Court and would establish an impracticable precedent of most baneful effect.

(3) The questions raised by the petition are not in fact presented by the case.

Respectfully submitted,

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Dated, September 22, 1949.